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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/986,981 | 11/13/2001 | Shayne Dunlap | 108800-00005 | 6013 |

7590

08/26/2003

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| EXAMINER |
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MARKS, CHRISTINA M

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| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,981

Applicant(s)

DUNLAP, SHAYNE

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in the United Kingdom on 06 December 2000 and 07 September 2001. It is noted, however, that applicant has not filed a certified copy of the UK 0029734.1 and the UK 0121712.4 applications as required by 35 U.S.C. 119(b).

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 1) player data including characteristic data, 2) the specifics claimed about the characteristic data, 3) access controls, 4) time restrictions, 5) successful completion requirements, 6) physical token, 7) storage medium, 8) key data, and 9) quantitative value data must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show how the player data includes characteristic data that can represent skill data. Further, the player data is not properly illustrated as to show how time restrictions are incorporated. Likewise, there is no illustration regarding the fact that the physical token is a storage medium containing the key data and how this token is used in the invention. Further, character generation is also described by not illustrated. For brevity purposes, the examiner states that pages 8-18 include a number of detailed descriptions relating to the invention that are not illustrated and do not reference a figure number or part. These details must be shown as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "accepting key data from each user terminal, each of the key data being indicative of a purchase of a physical token and being associated with player data." It is unclear to one of ordinary skill in the art the relationship that exists between the key data, the purchase of the physical token and the player data. One of ordinary skill in the art

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would not understand the correlation between the three items nor how the key data is used in the gaming system.

Claim 3 is indefinite because of the usage of the word “and/or” in line 8. The usage of the term renders the claim indefinite, as one of ordinary skill in the art would not understand what is meant to be included or excluded by the claim.

Claim 12 is indefinite because of the usage of the word “and/or” in line 8. The usage of the term renders the claim indefinite, as one of ordinary skill in the art would not understand what is meant to be included or excluded by the claim.

Claim 17 recites the limitation “accepting key data from each user terminal, each of the key data being indicative of a purchase of a physical token and being associated with player data.” It is unclear to one of ordinary skill in the art the relationship that exists between the key data, the purchase of the physical token and the player data. One of ordinary skill in the art would not understand the correlation between the three items nor how the key data is used in the gaming system.

Claim 19 is indefinite because of the usage of the word “and/or” in line 8. The usage of the term renders the claim indefinite, as one of ordinary skill in the art would not understand what is meant to be included or excluded by the claim.

Claim 28 is indefinite because of the usage of the word “and/or” in line 8. The usage of the term renders the claim indefinite, as one of ordinary skill in the art would not understand what is meant to be included or excluded by the claim.

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Regarding claim 7, this time restriction includes a fixed time window beyond which the entry fee for the tournament will no longer be valid (Column 4, lines 21-23).

Regarding claim 8, the time restriction includes a total time period and attempts to access the game after the initial time period are not allowed (Column 4, lines 20-24), as the system would recognize the entry fee has already been used to enable play.

Regarding claim 9, the initial time period can be extended upon a successful completion of a predetermined portion of the game (Column 8, lines 28-43).

Regarding claims 10 and 11, this predetermined portion can include reaching an assigned task of achieving a certain score (Column 8, lines 28-43).

Regarding claim 12, the successful completion includes reaching a predetermined value relating to the score, which is a measure of a combination of the listed elements (Column 8, lines 28-43; Column 15, lines 35-48).

Regarding claim 13, the prize is a cash prize (Column 8, lines 19-21).

Regarding claim 14, the value of the prize can be related to the number of players participating in the game session (Column 16, lines 32-37).

Regarding claim 15, as disclosed above the physical token can be a number of listed items from a credit card, to a debit card, to digital cash, thus as known in the art, the key data associated with payments would be stored on the physical token (Column 14, lines 59-63).

Regarding claim 16, as is known in the art and disclosed above, the physical tokens disclosed by Walker et al. inherently have a magneto-optical storage as is notoriously well known for credit cards.

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Regarding claim 17, Walker et al disclose an apparatus for interconnecting a plurality of users (FIG 1). The apparatus includes a gaming server (FIG 1, reference 102) that is programmed with gaming software (Column 5, lines 47-51). The functionality of the apparatus has been disclosed above in relation to the method and thus would be obvious that the apparatus executes the method.

Regarding claim 18, the player data includes characteristic data for the player (Column 7, lines 10-12).

Regarding claim 19, the characteristic data includes player strength, a player identity, performance levels, and one or more intellectual, physical or sociological characteristics (Column 7; Column 6, lines 27-49).

Regarding claim 20, the database of the central server represents initial values the first time the player registers and these values are updated as the user plays the game (Column 4, lines 30-31).

Regarding claim 21, the users access to the game is controlled by payment and reference to one or more of these characteristics (Column 7, lines 40-42).

Regarding claim 22, the data associated with the player includes time restrictions (Column 4, lines 21-25).

Regarding claim 23, this time restriction includes a fixed time window beyond which the entry fee for the tournament will no longer be valid (Column 4, lines 21-23).

Regarding claim 24, the time restriction includes a total time period and attempts to access the game after the initial time period are not allowed (Column 4, lines 20-24), as the system would recognize the entry fee has already been used to enable play.

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Regarding claim 25, the initial time period can be extended upon a successful completion of a predetermined portion of the game (Column 8, lines 28-43).

Regarding claims 26 and 27, this predetermined portion can include reaching an assigned task of achieving a certain score (Column 8, lines 28-43).

Regarding claim 28, the successful completion includes reaching a predetermined value relating to the score, which is a measure of a combination of the listed elements (Column 8, lines 28-43; Column 15, lines 35-48).

Regarding claim 29, the prize is a cash prize (Column 8, lines 19-21).

Regarding claim 30, the value of the prize can be related to the number of players participating in the game session (Column 16, lines 32-37).

Regarding claim 31, as disclosed above the physical token can be a number of listed items from a credit card, to a debit card, to digital cash, thus as known in the art, the key data associated with payments would be stored on the physical token (Column 14, lines 59-63).

Regarding claim 32, as is known in the art and disclosed above, the physical tokens disclosed by Walker et al. inherently have a magneto-optical storage as is notoriously well known for credit cards.

Claims 33-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent No. 6,224,486) in view of Barcelou (US Patent No. 6,048,271).

What Walker et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Walker et al. disclose a method of interconnecting a plurality of users via a communication network (FIG 1) wherein a plurality of computer terminals are connected to a remote sever. Walker et al. disclose accepting key data from each user terminal wherein the data is indicative of a token being associated with player data (Abstract). This key data is related to the payment of the entry fee and can be purchased as it is disclosed that digital cash can be used (Column 14, lines 58-67). It is notoriously well known in the art that digital cash can be in the form of a prepaid card, thus the usage of a physical token that is purchased would be obvious to one of ordinary skill in the art based upon the above disclosure of Walker et al. Furthermore, the system authenticates the associated input/output devices the players use, thus authenticating any communication and data sent from them (Column 4, lines 13-17). The system then allows each user to access an online game of skill or chance running on a server and playable via the respective terminal (Column 5, lines 47-51). The system accepts gaming inputs associated with the game from the terminals (Column 6, lines 7-12). Gaming data is provided to each terminal based upon the software and inputs from the user (Column 6, lines 7-12). The gaming data is also based upon the associated player data and key data (Column 6, lines 50-60; Column 7, lines 39-42). Upon completion and on the basis of the gaming software, one or more winners are determined (Column 7, lines 65-67; Column 8, lines 1-27).

Walker et al. do not specifically disclose how the physical token is interfaced with the computer terminal wherein the physical token has a memory within which key data is stored.

Barcelou discloses an online game method that enables users to access an interactive game via a computer terminal and a communication link (FIG 2a). Barcelou disclose interfacing a physical token with the computer terminal wherein the physical token has a memory with key

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data (FIG 2a). In order to achieve the desired functionality of payment for the game, the data is extracted from the physical token and provided to the remote server (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the smart card payment method of Barcelou into the system of Walker et al. Barcelou provides the proper interface to work with the disclosure of Walker et al. for payments. Using the disclosure of Barcelou, one of ordinary skill in the art would understand that a smart/card reader (the design and implementation of which are known in the art) would be obvious to the system of Walker et al. in order to implement the functionality of the credit and debit cards, as well as the digital money. One of ordinary skill in the art would be motivated to make this incorporation in order to provide a more convenient interface to the user.

Regarding claim 34, Walker et al. disclose that tournaments can be based on game of luck or chance, i.e. gambling games (Column 12, lines 40-50).

Regarding claim 35, Walker et al. discloses the game is played by a plurality of users via a corresponding terminal (FIG 1).

Regarding claim 36, the gaming data sent to each of the computer terminals is customized for the user based on the stored data for that user (Column 4, lines 30-35; Column 6, lines 4-12; Column 7, lines 40-45).

Regarding claim 37, Walker et al. discloses a number of cards with a value stored upon them, i.e. debit cards or digital cash. As per the disclosure of Barcelou, one of ordinary skill in the art understands that when digital cash is placed on a smart card, a memory storing the value of the card will be associated with it.

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Regarding claims 38 and 39, Walker et al. disclose a slot machine embodiment.

However, Walker et al. do not disclose the award outcome associated with the slot game. It is notoriously well known in the art that when a slot machine event is won the quantitative data relating to the award for the event is increased and when the event is lost, the data is decreased.

Regarding claim 40, Walker et al. discloses that records of payment to the player are stored in the central database (Column 16, lines 30-32; Column 6, lines 60-65).

Regarding claim 41, Walker et al. disclose that access to the central server for the game can be limited on a time basis (Abstract).

Regarding claim 42, Walker et al. disclose a fixed time period for the usage of the gaming system. Walker et al. disclose this as a fixed time period set for the game. It would have been obvious to Walker et al. to apply this time period in other manners such as limiting the amount of time the player can play, as opposed to limiting the time frame in which play can occur.

Regarding claim 43, Walker et al. disclose that this time period can be associated with a predetermined time (Column 9, lines 18-2). This time period axiomatically includes a date, as it would be impractical to not associate a time for starting a game with a date for the game.

Regarding claim 44, Walker et al. discloses awarding the player extended time by moving them from one round to the next (Column 9, lines 40-45). Walker et al. states that this method of rewarding would equal apply to games of chance (Column 9, lines 46-52), such as gambling.

Regarding claim 45, the prize includes the option to extend the original time to access the game, as the player has the option to continue play upon winning (Column 4, lines 37-38).

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Regarding claim 46 and 47, a credit is required to access and the token axiomatically includes an initial credit value (Abstract; Column 4, lines 18-20).

Regarding claim 48, if no payment is made, and thus the credit reaches a lower level, access will not be granted into the system (Column 6, lines 49-67).

Regarding claim 49, Walker et al. disclose a number of cards with a value stored upon them, i.e. debit cards or digital cash. As per the disclosure of Barcelou, one of ordinary skill in the art understands that when digital cash is placed on a smart card, a memory storing the value of the card will be associated with it.

Regarding claim 50, Walker et al. disclose cash prizes (Column 8, lines 19-25), thus representing an increase in the number of credits when applied to the key data.

Regarding claim 51, the game is won upon completing a predetermined portion or acquiring a predetermined score (Column 8, lines 29-43).

Regarding claim 52, the prize is a cash prize (Column 8, lines 19-21).

Regarding claim 53, the value of the prize can be related to the number of players participating in the game session (Column 16, lines 32-37).

Regarding claim 54, as disclosed above the physical token can be a number of listed items from a credit card, to a debit card, to digital cash, thus as known in the art the key data associated with their payments would be stored on the physical token (Column 14, lines 59-63).

Regarding claim 55, as is known in the art and disclosed above, the physical tokens disclosed by Walker et al. inherently have a magneto-optical storage as is notoriously well known for credit cards.

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Regarding claim 56, an apparatus for enabling the user to access the network would be axiomatic to the method of Walker et al. being carried out and thus would be obvious to the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 5,779,549: Online tournament with payment for a fixed time period and winner can advance payment of time period.


US Patent No. 4,764,666: Online lottery system where a user uses a prepaid monetary card to purchase tickets.

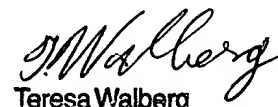
US Patent No. 6,048,271: Online game of skill wherein the user can purchase tokens of play with a smart card and then the winner is awarded the prize.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.


cmm
August 19, 2003


Teresa Walberg
Supervisory Patent Examiner
11/10/03

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Regarding the Applicant's argument that Walker does not associate key data with player data, Walker et al. expressly disclose this feature in that the information input by the player as key data is used to retrieve profiles with player information.

Regarding the Applicant's argument about credit and debit cards and physical tokens, the Examiner asserts that while a likeness was associated, the Applicant is ignoring the rest of the Walker et al. disclosure and the Examiner's presentation of what the disclosure means to a skilled artisan, such as digital cash.

Regarding the Applicant's argument that there is no motivation to combine the teachings of Barcelou and Walker and that it would not be obvious to a person skilled in the art to introduce a different payment technique into the context of Walker et al., the Examiner respectfully disagrees. Walker et al. explicitly states, "There are many different ways for a player to pay his entry fee (Column 14, lines 59-67)." Thus, Walker et al.'s own disclosure states the obviousness of different payment techniques. It would have been unnecessary disclosure for Walker et al. to name every possible payment method known in the art. Further the Examiner reminds the Applicant, the Barcelou patent was relied on for its ability to read a smart card and to extract key data.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cmm
March 12, 2004



MICHAEL O'NEILL
PRIMARY EXAMINER